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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,522	10/07/2003	Ravi Kuchibhotla	CS23738RL	5055

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EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/680,522	KUCHIBHOTLA ET AL.	
	Examiner	Art Unit	
	Charles N. Appiah	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 18 is/are allowed.
- 6) ☒ Claim(s) 14-17, 19, 21, 22 and 25-38 is/are rejected.
- 7) ☒ Claim(s) 20, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on June 22, 2005 have been fully considered but they are not persuasive.

In regard to applicant's argument with respect to the rejection of claims 27-33 under 35 USC 101, that "contrary to the examiner's assertion, claims 27, 29, and 33 are drawn to statutory subject matter, particularly claims 27-33 are drawn to practical applications of electromagnetic energy. See MPEP 2106, IV, B, 1 (c) "Natural Phenomena such as Electricity and Magnetism", examiner maintains that the cited portion of the MPEP 2106... does not apply since the claims recite only "a wireless communication system message" and structure without any practical application of electromagnetic energy. The message as claimed in claim 27-33 is not capable of being detected, transmitted or received since it is not embodied on a carrier wave.

In view of the above the rejections of claims 27-33 under 35 USC 101 are maintained.

### ***Claim Rejections - 35 USC § 101***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 27-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 27-33 are drawn to a "wireless communications system information message" and "a wireless communications system information broadcast message" i.e.,

a signal, *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Signals not claimed as embodied on a carrier wave are descriptive material, *per se* and are not statutory because they are not capable of causing functional change in the wireless communications system. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a signal *per se* held nonstatutory). Such claimed signals (messages) do not define any physical means of realizing the message to be transmitted, received or detected in regard to the structural and functional interrelationships between the message and other claimed aspects of the invention, which permit the message structure's functionality to be realized.

***Claim Rejections - 35 USC § 112***

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of the limitation "information about the multiple core networks indicating how many multiple core networks share the common access network" in claims 5 and 6 lack clear antecedent basis in the claims since it is not clear if "information" is related to "network system information" received.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14-17, 19, 21,22, 26, 34, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Mildh et al. (US 2002/0193139).

Regarding claim 14, Mildh discloses a method in a communication device, the method comprising: receiving system information, the system information including pointer information indicating where the communication device may obtain information about multiple core networks sharing a common access network from which the system information was received (mobile being furnished with parameter information pertaining to mode of operation, see page 1, [0009-0010], page 2, [0014-0017] and page 3, [0029-0032]), attempting to connect to a core network based on the information about multiple core networks sharing the common access network from which the system information was received (mobile making a selection of a cell after decoding information from a specific system information message or a parameter in the existing PSI/SI message, see page 2, [0018-0019]).

Regarding claim 15, Mildh further discloses selecting the one of the multiple core networks to which the communication device attempts to connect using the information about multiple core networks sharing the common access network from which the system information message was received (see page 2, [0018]).

Regarding claim 16, Mildh further discloses obtaining an identity for the core network to which the communication device attempts to connect using the pointer information (see page 2, [0016]).

Regarding claim 17, Mildh further discloses the system information including a common identity for the multiple core networks sharing the common access network (see page 2, [0016]), attempting to connect to one of the multiple networks sharing the common access network from which the system information was received upon satisfaction of a condition (see page [0016]), attempting to connect to a core network using the common identity when the condition is not satisfied (mobile station resorting to a default solution that can be specified in a network standard, page 2, [0017]).

Regarding claims 19 and 25, Mildh discloses a method in a communication device, the method comprising: receiving first system information from a first access network (GERAN) and receiving second system information from a second access network (UTRAN), the first system information including a first core network identity and information on how many core networks share the first access network (see page 1, [0009-0010], page 2, 0014-0015]), the second system information including a second core network identity (see page 2, [0016]), selecting one of the first and second core network identities based on the number of core networks sharing the first access network.

Regarding claim 21, Mildh further discloses selecting the one of the first and second identities randomly (see page 2, [0016]).

Regarding claim 22, Mildh further discloses selecting the one of the first and second identities only if the first and second access networks satisfy a quality condition (see page 3, [0036-0037]).

Regarding claim 26, Mildh further discloses receiving the information in response to an unsuccessful core network connection attempt

Regarding claims 34 and 36, Mildh discloses a method in a communication network entity, the method comprising: receiving preferred core network information from a communication device (feature of a preference for one of the interfaces set in the mobile station, see page 3, [0035]), selecting a core network for the communication device by giving consideration to the preferred core network information received from the communication device when selecting the core network for the communication device (subscriber using IP multimedia services always selecting the 3G core network, see page 3, [0035-0039]).

Regarding claim 35, Mildh further discloses receiving the at least one preferred core network from a communication device in a connection request (feature of a subscriber using IP multimedia services always selecting the 3G core network in an inherent connection request, see page 3, [0035]).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mildh et al as applied to claim 36 above, and further in view of Well-Known Prior Art (Official Notice)

Regarding claims 37 and 38, Mildh further discloses core network (CN) selection based on user identity, mobile capability and location in mixed networks (see page 1, [0010], and inherently receiving a connection request from the communication device (feature of a subscriber using IP multimedia services always selecting the 3G core network in an inherent connection request, see page 3, [0035])).

but fails to explicitly teach receiving the communication device identity from the communication device in response to the network entity requesting the communication device identity or requesting the communication device identity in response to receiving the connection request from the communication device.

However, the concept of authentication in wireless communication networks is very well known and expected in the art and as such examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to provide for an authentication procedure whereby the network requests a subscriber's identity which must be provided by the subscriber in order to ensure that communication services are provided to legitimate subscribers who request access to communication services and based on what is subscribed to thus prevent fraudulent use of communication resources and services.

***Allowable Subject Matter***

8. Claims 1-13 and 18 are allowed.



9. Claims 20, 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rajaniemi et al. (6,792,277) discloses a system for control signaling in a telecommunications system having multiple core networks.

Huusko et al. (6,397,065) discloses a cellular radio access network having different core networks.

Hogan et al. (2003/0040313) discloses a method for location area updating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

A handwritten signature in black ink, appearing to read 'Charles Appiah', with a stylized, cursive script.

**CHARLES APPIAH  
PRIMARY EXAMINER**